

REMARKS

The Office Action mailed on August 9, 2010, has been reviewed and the comments of the Examiner carefully considered. Claims 3, 5, 7, 10, 14, 15, 19, 20, 23 and 31 are amended herein. Claims 1-25, 30 and 31 are under consideration.

Claim Objections

Claim 15 was objected to for containing a grammatical error. Applicants have corrected this error, obviating the claim. Applicants also noticed a similar grammatical error in claim 14 and have edited claim 14 accordingly.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 3, 5, 7-25 and 31 were rejected as allegedly indefinite for various reasons. Applicants address each of the rejections in turn below.

Claims 3, 5, 7, 10, 19, 23 and 31 were rejected as allegedly indefinite for including both broad and narrow overlapping limitations within the same claim. Applicants have amended the claims herein to remove the narrower limitations.

Claim 3 was rejected as allegedly indefinite for reciting an improper Markush group. Applicants have amended the claim to properly recite the Markush group.

Claim 14 was rejected as allegedly indefinite for lacking reference to the variable “m”. Applicants have amended the claim herein to properly refer to the variable “m”.

Claim 20 was rejected as allegedly indefinite for not having proper antecedent basis for the term “polysaccharide”. Applicants have amended the claim to depend from claim 2 and have proper antecedent basis.

Accordingly, Applicants respectfully submit that the amended claims are not indefinite, and request withdrawal of the rejection of claims under 35 U.S.C. § 112, second paragraph.

Rejection under 35 U.S.C. § 112, First Paragraph

Claim 4 was rejected as not being fully enabled under the 35 U.S.C. § 112, first paragraph. The rejection alleges that the specification enables claim 4 for acrylic polymers

having carboxyl groups, but not for all of the claimed acrylates. While claim 4 depends from claim 1, which is directed to a carboxylic linkage to the claimed polymer, Applicants point out that there is description and explanation in the specification as to how one of skill in the art would derivatize oxidized regenerated cellulose to form active, available carboxylic acid groups. This disclosure in the specification provides abundant guidance to the skilled artisan seeking to derivatize acrylic polymers. This support can be found throughout the specification, and for example, in paragraphs [0026]-[0027] of the published application. Applicants therefore submit that claim 4 is fully enabled by the specification.

Rejection under 35 U.S.C. § 102(b)

Claims 1, 4-8, 10 and 14-19 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,039,940 of Perrault et al. It is the Examiner's view that the polymer taught in Perrault can be the same as the polymer in the present claims. Applicants respectfully traverse the Examiner's rejections for the following reasons.

It is well-settled that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) and also MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil C. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ...claim". *Id.* (quoting *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Therefore, the Perrault reference must describe each and every element of the claims in order to anticipate these claims under section 102(b). However, Perrault does not meet this burden.

A clear reading of Perrault reveals that the $\{H_2C\}_n$ moiety in the middle of the referenced structure is not drawn or disclosed to be a divalent hydrocarbon radical. Claim 1, and the remaining claims (all of which ultimately depend from claim 1), require the moiety in that position, "R", to be a divalent hydrocarbon radical. Therefore, because this reference does not disclose the entire claimed invention, it cannot anticipate the invention under 35 U.S.C. § 102(b). Accordingly, Applicants respectfully submit that the presently-pending claims are not anticipated by the cited references, and request reconsideration and withdrawal of the anticipation rejection.

Rejection under 35 U.S.C. § 103(a)

Claims 1-3 and 5-25 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of Namikoshi et al. (U.S. Pat. 4,877,617) in view of Abel et al. (Carbohydrate Research 337 (2002) 2495-2499) as evidenced by Cohen et al. (Tetrahedron Letters 39 (1998) 8617-8620) and Hardy (U.S. Pat. 6,022,556). Claims 30 and 31 were rejected as obvious for different reasons under the same references. Applicants traverse these rejections for the same reason as set forth for the anticipation rejection above. In particular, nothing in any of the combined references leads the reader to arrive at the specific compositions set forth in the pending claims.

The test which must be met for a reference or a combination of references to establish obviousness has not been satisfied in the instant matter. The MPEP states, in relevant part, the proper test for obviousness:

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103 ...

[T]he four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations. (MPEP § 2141).

When applying 35 U.S.C. § 103, the following tenets of patent law must be followed: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. MPEP § 2141 II. This test has not been satisfied here for the obviousness rejections.

The obviousness rejection appears to be premised on the view that despite the fact that all of the specific aspects of the presently-claimed compositions are not taught or suggested by the prior art, the skilled artisan would nonetheless know to arrive at the claimed compositions. Applicant respectfully submits that this conclusion is unsupported in the office action. The references, when combined or when taken individually, do not provide the skilled artisan with

any reasonable expectation of success in arriving at the claimed compositions. The references merely provide evidence of various individual aspects of Applicants' entire invention. The office action does not provide the requisite evidence to create a *prima facie* case of obviousness.

MPEP 2141 requires that "Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103." (Emphasis added). These requirements have not been met in the present case. It has not been shown that the cited references provide any suggestion or motivation for establishing the specifically-claimed compounds, nor has it been shown that the references provide any teaching or suggestion as to why one of skill in the art could arrive at the claimed compositions based on the various incomplete evidence provided by the cited art. The Office Action merely speculates that a person of skill in the art would automatically recognize how to prepare such compositions by viewing the various unconnected aspects of the prior art. The skilled artisan simply has no reasonable expectation of success in arriving at Applicant's present claims, and the Office Action provides no evidence to the contrary.

MPEP 2142 requires that in order to establish a *prima facie* case of obviousness, "...rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Citing *in re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). The statements in the present Office Action, however, are merely conclusory.

When the prior art is viewed as a whole, it is found that the references, either taken alone or in combination, do not provide any teaching or motivation for the skilled artisan to arrive at the present claims, *when the claimed invention is properly viewed as a whole*. In the present Office Action, the obviousness rejection is based on that which was disclosed for the first time in the present patent application. The rejections in the Office Action require what is disclosed in the present claims themselves in order to illustrate the alleged obviousness. Therefore, the rejection is improper and Applicant respectfully requests withdrawal of the rejection.

Because the rejected claims are not obvious in view of the cited references, as set forth above, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103(a).

Conclusion

Applicant respectfully submits that the all of the rejections have either been overcome or rendered moot. The claims are therefore in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5089 to clarify any unresolved issues raised by this response.

The Director is hereby authorized to charge/credit Deposit Account No. **50-0310** (Billing No. 101713-5056) for any required fees, deficiencies or overpayments in connection with this Response.

Respectfully submitted,
FARAIA SHAH ET AL.

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